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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/487,526	06/07/95	HARVEY J	5634.355

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EXAMINER	
LUTHER, W	
ART UNIT	**PAPER NUMBER**
2731	19

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

☆U.S.GOVERNMENT PRINTING OFFICE 1995-319-826

Office Action Summary

Application No.	Applicant(s)
08/487,526	HARVEY et al
Examiner	**Group Art Unit**
William Luther	2731

☒ Responsive to communication(s) filed on *Mar 9, 1998* .

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *2-20* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *2-20* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. This action is in response to Amendment D received on March 9, 1998.

Response to Arguments

2. Applicant's arguments with respect to claims 2-20 have been considered but are moot in view of the new ground(s) of rejection.

First the administrative requirement is maintained. Second it is re-noted that the priority date of the instant disclosure is claimed by applicant to the '81 document (U.S. patent no. 4,694,490 filed Nov. 3, 1981). At issue is whether prior art suggests the newly added limitations (combined with the existing limitations) corresponding to the instruct signals, specific portions, and organization of the specific portions. However, Campbell et al are found to suggest the breadth of the newly added limitations. Particularly, Campbell et al receive combined video and teletext for a single multimedia programming presentation display (video, teletext, and audio) according to Figure 12 instructions to coordinate wherein the teletext is organized so as to overlay the video background.

DOUBLE PATENTING BETWEEN APPLICATIONS

3. Conflicts exist between claims of the following related co-pending applications which includes the present application:

#	Ser. No.	#	Ser. No.	#	Ser. No.
1	397371	2	397582	3	397636
4	435757	5	435758	6	437044
7	437045	8	437629	9	437635
10	437791	11	437819	12	437864
13	437887	14	437937	15	438011
16	438206	17	438216	18	438659
19	439668	20	439670	21	440657
22	440837	23	441027	24	441033
25	441575	26	441577	27	441701
28	441749	29	441821	30	441880
31	441942	32	441996	33	442165
34	442327	35	442335	36	442369
37	442383	38	442505	39	442507
40	444643	41	444756	42	444757
43	444758	44	444781	45	444786
46	444787	47	444788	48	444887
49	445045	50	445054	51	445290
52	445294	53	445296	54	445328

55	446123	56	446124	57	446429
58	446430	59	446431	60	446432
61	446494	62	446553	63	446579
64	447380	65	447414	66	447415
67	447416	68	447446	69	447447
70	447448	71	447449	72	447496
73	447502	74	447529	75	447611
76	447621	77	447679	78	447711
79	447712	80	447724	81	447726
82	447826	83	447908	84	447938
85	447974	86	447977	87	448099
88	448116	89	448141	90	448143
91	448175	92	448251	93	448309
94	448326	95	448643	96	448644
97	448662	98	448667	99	448794
100	448810	101	448833	102	448915
103	448916	104	448917	105	448976
106	448977	107	448978	108	448979
109	449097	110	449110	111	449248
112	449263	113	449281	114	449291

115	449302	116	449351	117	449369
118	449411	119	449413	120	449523
121	449530	122	449531	123	449532
124	449652	125	449697	126	449702
127	449717	128	449718	129	449798
130	449800	131	449829	132	449867
133	449901	134	450680	135	451203
136	451377	137	451496	138	451746
139	452395	140	458566	141	458699
142	458760	143	459216	144	459217
145	459218	146	459506	147	459507
148	459521	149	459522	150	459788
151	460043	152	460081	153	460085
154	460120	155	460187	156	460240
157	460256	158	460274	159	460387
160	460394	161	460401	162	460556
163	460557	164	460591	165	460592
166	460634	167	460642	168	460668
169	460677	170	460711	171	460713
172	460743	173	460765	174	460766

175	460770	176	460793	177	460817
178	466887	179	466888	180	466890
181	466894	182	467045	183	467904
184	468044	185	468323	186	468324
187	468641	188	468736	189	468994
190	469056	191	469059	192	469078
193	469103	194	469106	195	469107
196	469108	197	469109	198	469355
199	469496	200	469517	201	469612
202	469623	203	469624	204	469626
205	470051	206	470052	207	470053
208	470054	209	470236	210	470447
211	470448	212	470476	213	470570
214	470571	215	471024	216	471191
217	471238	218	471239	219	471240
220	472066	221	472399	222	472462
223	472980	224	473213	225	473224
226	473484	227	473927	228	473996
229	473997	230	473998	231	473999
232	474119	233	474139	234	474145

235	474146	236	474147	237	474496
238	474674	239	474963	240	474964
241	475341	242	475342	243	477547
244	477564	245	477570	246	477660
247	477711	248	477712	249	477805
250	477955	251	478044	252	478107
253	478544	254	478633	255	478767
256	478794	257	478858	258	478864
259	478908	260	479042	261	479215
262	479216	263	479217	264	479374
265	479375	266	479414	267	479523
268	479524	269	479667	270	480059
271	480060	272	480383	273	480392
274	480740	275	481074	276	482573
277	482574	278	482857	279	483054
280	483169	281	483174	282	483269
283	483980	284	484275	285	484276
286	484858	287	484865	288	485282
289	485283	290	485507	291	485775
292	486258	293	486259	294	486265

295	486266	296	486297	297	487155
298	487397	299	487408	300	487410
301	487411	302	487428	303	487506
304	487516	305	487526	306	487536
307	487546	308	487556	309	487565
310	487649	311	487851	312	487895
313	487980	314	487981	315	487982
316	487984	317	488032	318	488058
319	488378	320	488383	321	488436
322	488438	323	488439	324	488619
325	488620	326	498002	327	511491
328	485773	329	113329		

4. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. The attached Appendix provides clear evidence that such conflicting claims exist between the 329 related co-pending applications identified above. However, an analysis of all claims in the 329 related co-pending applications would be an extreme burden on the Office requiring millions of claim comparisons.

In order to resolve the conflict between applications, applicant is required to either:

(1) file terminal disclaimers in each of the related 329 applications terminally disclaiming each of the other 329 applications, or;

(2) provide an affidavit attesting to the fact that all claims in the 329 applications have been reviewed by applicant and that no conflicting claims exists between the applications. Applicant should provide all relevant factual information including the specific steps taken to insure that no conflicting claims exist between the applications, or;

(3) resolve all conflicts between claims in the above identified 329 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 329 applications (note: the five examples in the attached Appendix are merely illustrative of the overall problem. Only correcting the five identified conflicts would not satisfy the requirement).

Failure to comply with the above requirement will result in abandonment of the application.

Claim Rejections - 35 U.S.C. § 112

5. Claims 2-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Considering claim 2, the claim is vague and indefinite for not providing sufficient antecedent reference for "said at least two or more specific portions" (lines 34 and 39). Suggestion is made to amend the second set of steps 1-8 so that they recite --specific-- prior to "portion" or "portions" (as the case may be).

Claim Rejections - 35 U.S.C. § 103

6. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Rejections are made with Examiner's best understanding of scope of claims. Any amendment to overcome rejection under 35 U.S.C. 112 that changes Examiner's understanding of claim scope may necessitate citation of new art.

7. Claim 2, 4-12, and 18-20 are rejected under 35 U.S.C. § 103 as being unpatentable over Campbell et al (U.S. patent no. 4,536,791).

Considering claim 2, Campbell et al suggest: communicating information at a multimedia receiver station (addressable converter, item 40 Figure 1); the receiver station (addressable converter) containing one or more receivers (item 40 is suggested by Campbell et al Figure 6 wherein item 100 receives multimedia signaling); a computer connected to the receiver for processing and communication information (Campbell et al Figure 7 shows dissection of Figure 6 item 104 in which computer 410 of Figure 7 receives video and graphics from Figure 6 item 100); a plurality of output devices (Figure 7 shows the process of channeling information to graphics output circuitry and also to video output circuitry); inputting a subscribers command (Figure 12 item 334 inputs key word) is suggested by Campbell et al when subscribers desire to watch special events, higher tiers, or any unauthorized programming; controlling the receiver station to receive a signal (Fig 11 item 200) in response to the key word entry (subscriber command) the signal (Fig 11 item 200) comprising a signal (same or different??- either Fig 11 item 200 or Fig 11 item 206 depending on whether 'a signal' is meant to be same or different than previous recitation) which permits operation of the receiver station in a designated media operation (Campbell et al suggests that the threshold code be entered by the user, col 14 line 18, which effects signal 200 to comprise a corresponding 206 permitting operation or the receiver station to allow previously ineligible programming); detecting the presence of two or more instruct-to-coordinate signals (a first signal suggested by Campbell et al is channel control word signal 200 of Figure 11, the second signal is

the event enable word signal 220) at the receiver station; each instruct-to-coordinate signal designating: channel control word designates (1)-a portion of multimedia programming signal to receive by designating tier code (Figure 11, item 200 with item 202) and event enable word signal 200 designates (2)- a portion of a multimedia programming signal to communicate to a memory location wherein items 222, 224, 226, 228 are stored in item 104 (see col 13 line 61 thru col 14 line 8); communicating one or more units of multimedia programming in response to the two-or more instruct-to-coordinate signals (Campbell et al suggest that after special event codes are stored in item 104 in response to entry of keyword an activation of channel number 226, that the special program be output to the requesting subscriber). *Further, Campbell et al are found to suggest combined video and teletext for a single multimedia programming presentation display (video, teletext, and audio;these features are inherent that necessary to allow receiver end users to view that which is generated by HPV Figure type circuitry) according to Figure 12 instructions to coordinate wherein the teletext is organized so as to overlay the video background.*

What Campbell et al does not specifically suggest is television programming displays that promotes a multi-media product or service. However it would have been obvious to one having ordinary skill in the art of digital communication to promote special events available on non-authorized channels so that subscribers would become aware of any event of interest and then order that event, ie advertise for the well known purposes of increasing viewership and therefore revenue (both from the subscriber, and if advertising is permitted on those channels then from

other advertisers). As an alternative, the promotion is inherent because the teachings include broadcasting network television which airs commercials (so notoriously old in television and rendered obvious by radio before the invention of television).

Considering claim 4, Campbell et al suggest Fig 11 item 216 wherein the receiving station is programmed to allow viewing of some channels but not others (other control words such as address are considered associated identification datum).

Considering claim 5, Campbell et al suggest processing received programming based on a predetermined fashion by comparing a requested channel to an authorized channel and then making a decision whether to switch to graphics display and key word entry prompt or to allow viewing of the selected program and channeling video signal to video descrambler (see associated Fig 12 item 334 and Figure 7 item 101).

Considering claim 6, Campbell et al suggest processing subscriber command (entered key word-see Fig 12 item 334) based on said one or more instruct-to-coordinate signals (the one instruct-to-coordinate signal associated with entered key word signal 200 having the effect on signal 206- see Figure 11).

Considering claim 7, Campbell et al suggest processing viewer's reaction (to a prompt for key word entry) based on one of said one or more instruct-to-coordinate signals (the 206 instruct to deny eligibility to some requested programs) and outputting some programming to a second output device (the video/audio output associated with the descrambling path 101 of Figure 7) based on inputting and processing (of either the key word, or a change in eligibility threshold).

Considering claim 8, Campbell et al suggest processing the subscriber command (key word item 334 Figure 12), and communicating information based on the step of entering the key word to the remote station based on inputting and processing (the hub end remote station monitors those viewed channels via two-way-interactive cabling (col 3 line 24).

Considering claim 9, Campbell et al suggest two-way-cable communication (see rejection to claim 2 above) specifically from subscriber to remote data collection stations which include: inputting viewers reaction at a subscriber station (prompt for key word entry item 334 Figure 12); receiving at a subscriber station information that designates an instruct signal to process or output to deliver in consequence of specific subscriber input (specific subscriber inputs of eligibility threshold setting or keyword entry allows deliverance of a previously in-eligible program to be outputted to the subscriber; determining the presence of specific subscriber input at the subscriber station by processing and viewers or participants reaction (matching entered key word to predetermined key word by processing entered keyword); processing an instruct signal (word 230 Figure 11) effective to coordinate multimedia programming presentation based on the subscriber input (key word or newly entered eligibility threshold) at the subscriber station in consequence to the step of determining; transferring from the subscriber station to one or more remote data collection stations an indicia confirming delivery of the instruct signal (word 230 Figure 11) from the step of processing or conforming delivery of the same from the step of processing (the system monitors viewed programs, col 3 line 24 for purposes which include billing, statistic gathering, etc...).

Considering claim 10, storing subscriber instruction to receive one or specific mass medium programs, data, news items, or computer control instructions (the hub end stores tier code item 202 Figure 11, eligibility threshold code item 238 Figure 11, etc... based on subscriber authorization); and receiving one or more specific mass medium programs, data, news items, or computer contorts instruction in accordance with the instructions (col 16 lines 47-59 are suggested programs available based on tier code item 202 Figure 11, eligibility threshold code item 238 Figure 11, etc...).

Considering claim 11, Campbell et al suggests: the instruct signal (eligibility threshold code) input by the subscriber (col 14 line 18) storing subscriber instruction (event enable word is stored in item 104 see col 13 lines 61 thru col 14 line 8) to process or present one or more mass medium programs; processing or presenting one or more specific mass medium programs with the instruction (when the special event is broadcast then the special event is made available via video descrambling circuitry -Figure 7 item 101).

Considering claim 12, Campbell et al suggest that the information with designates a specific subscriber input or said instruct signal (eligibility threshold code) is detected in an information transmission from a data or programming source. The processor suggested by Campbell et al is inherently programmed to respond to data from the programming source hub end transmitter. The programs are received. The detector 100 of Figure 6 does detect programming and control signaling wherein both data and control signaling and instruct signaling are passed to item 104 of Figure 6.

Considering claim 18, Campbell et al suggest controlling the remote intermediate data transmitter station (see rejection to claim 2 above) to communicate data to one or more receiver stations, with the remote transmitter station including a broadcast or cablecast transmitter for transmitting one or more signals which are effective at a receiver station to instruct a computer or processor (Campbell et al abstract and Figure 7 processor 410; particularly not that the user of the receiving station enters an eligibility threshold code col 14 line 18 which is effective to allow viewing of pre-authorized programming and hence instruct processor 104 of Figure 6 to control the programming reception); a plurality of selective transmission devices (video device circuitry Figure 7 item 101 or graphics device circuitry Figure 7 item 124);a data receiver (Figure 6); control signal detector (item 104 or internal circuitry of item 104 depicted in Figure 7); controller or computer (item 410 of Figure 7) for detecting the control signaling (depicted in Figure 11) for controlling program output based on the eligibility code 206; for step (1) receiving instruct signaling item 238 must be received by the transmitter station in order to be transmitted back to the receiver station as illustrated by Figure 11 (see discussion of eligibility code threshold authorization in col 14 line 18); for step (2) control signals are inherently used to communicate the eligibility threshold code. While Campbell et al do not explicitly teach transmission before a specific time. A specific time is merely considered the time the control signals are transmitted and therefore would have been obvious in view of Campbell et al suggestions. With regard to the limitations added and deleted per Amendment C filed August 13,1997, attention is called to the above rejection. Further, the deletion of "for transmitting...computer or processor" (lines 4-5)

and the addition of --at least one instruct signal-- (line 2) while being different in scope, are still met by that cited in parenthesis associated in the above rejection to the deleted recitation. The added limitations --for receiving ...at least one origination transmitter station-- (lines 8-9) are suggested by Campbell et al suggestion by the inherence of the system operator having control over system operations including the instruct signals depicted in Figure 11 wherein the 'origination station' is suggested by the station (location) at which the system operator sits and operates. Further, because the console from which the system operator sits and the surrounding area such as the desk, room, etc. and any combination of these elements may be considered the origination station, then the system operator can enter the data for instructing the receiver station into the intended keyboard so as some down line circuitry at that location which can be called the 'origination station' can receive the keyboard input and transmit it via the intermediate station and onto the receiver station. Therefore, the added limitations of lines 17, 18, and 19 are inherent to the operation of the system suggested by Campbell et al. Finally, the added recitation of 'transfer' are met by the suggestions above associated to 'transmission devices'.

Considering claim 19, Campbell et al suggest embedding specific one of said one or more control signals within the information transmission between the transmitter station and the receiver station. Regarding the added limitations, the embedding of control signaling in the instruction signaling is suggested by Campbell et al for entering by the system operator at his origination station for subsequent transmission through the intermediate station and onto the receiver station (see fig 11).

Considering claim 20, Campbell et al suggests the first 'or' grouping that the specific time is a scheduled time as programming suggested by Campbell et al is scheduled. Regarding the language of 'transfer devices' (last line) in substitution for "transmitter devices", per discussion above at the end of claim 18, what is set forth as transmitter devices in the rejection also reads on reasons on 'transfer devices' per broad and reasonable definition.

8. Claims 13-16 are rejected under 35 U.S.C. § 103 as being unpatentable over Campbell et al (U.S. patent no.4,536,791) in view of Lambert (US patent no. 4,381,522).

Considering claim 13, Campbell et al suggest the invention (see rejection to claim 2 above): communication between a transmitter station and a receiver station (abstract; also see rejections above); including delivery of media to the receiver station from the transmitter station via a transmitter (it is inherent to the process or receiving programs at the receiver station for the programs to be delivered to a transmitter for transmitting to that receiver station); the transmitter station receives signaling of an eligibility threshold code from the receiver station (col 14 line 18; note Figure 11 shows signaling in the direction of the transmitter station to receiver station including item 238 necessitating that the eligibility threshold was first communicated in the direction of the receiver station to the transmitter station after authorization of a certain eligibility threshold code is given prior to subsequent Figure 11 depiction of the threshold being transmitted back to the receiver station as item 238); the eligibility threshold code or the eligibility code item 206 or item 200 channel control word (considered instruct signaling) operates at the receiver station to coordinate which programs will be viewed upon request based on tier etc....; Campbell

et al, per discussion above, do communicate at least one signal of eligibility threshold code in order for it to be transmitted back as item 238. What Campbell et al does not explicitly teach the control signals for controlling communication of the programming. However, Lambert suggests a two-way cable system for transmitting programs at a users request for convenience wherein control words thus control the communication. It would have been obvious to one having ordinary skill to implement on demand programming for the benefit of meeting the users personal schedule. Regarding the Amendment C adding further limitation "subscriber reaction" (line 11) as a substitution for "response", the suggestions formerly submitted as reading on 'response are also considered sufficient to read on 'subscriber reaction' because this is the nature of what is opinion polling (col 3 line 24).

Considering claim 14, embedding one or more control signals in the unit of programming before transmitting the unit to the remote transmitter stations is inherent to Campbell et al suggestions. The added limitations per Amendment C are met by the signaling depicted in Fig 11 as well as other signaling discussed by Campbell et al.

Considering claim 15, Campbell et al suggest that the unit of programming comprises audio or text, or video.

Considering claim 16, the unit of programming is suggested to be a television program by Campbell et al.

9. Claim 3 is rejected under 35 U.S.C. § 103 as being unpatentable over Campbell et al (U.S.

patent no. 4,536,791) as applied to claim 2 above, and further in view of Nagel (U.S. patent no. 4,064,490).

Considering claim 3, Campbell et al suggest claimed subject matter including the display of stock market quotations, news stores, stock quotations etc... (col 16 lines 48-56) but does not suggest programming the receiver for portfolio. However, Nagel suggests a receiving station computer for real-time stock portfolio analysis (col 12 line 42). It would have been obvious to one having ordinary skill to combine portfolio analysis suggestions of Nagel with the stock retrieval system and associated news items for the benefit of a providing the subscriber a more informed body of information for which to make portfolio adjustments for more secure investing.

10. Claim 17 is rejected under 35 U.S.C. § 103 as being unpatentable over Campbell et al (U.S. patent no. 4,536,791) in view of Lambert (U.S. patent no. 4,381,522) as applied to claim 13 above, and further in view of Nagel (U.S. patent no. 4,064,490).

Considering claim 17, Campbell et al suggest claim recitation with the exception of downloadable executable code. However, Nagel suggest downloadable executable code in a receiver micro-processing teletext environment. It would have been obvious to one having ordinary skill to combine Campbell et al and Nagel for the benefit of providing more user functionality at the subscriber unit for performing various tasks such as stock portfolio analysis.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Luther whose telephone number is (703) 308-6609. The examiner can normally be reached on M-Fri from 9:30am to 3pm. The fax phone number for this art unit is (703) 308-5403.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

William Luther
June 22, 1998